

The present invention provides for a structured WorkFolder for organizing electronic documents in a self-contained data repository. The WorkFolder comprises sections for grouping related documents. One type of section is a Contents Node which serves as a base to which structural elements of the WorkFolder are linked. One such type of structural element is a space-reserving placeholder for indicating a document expected to be placed in the WorkFolder. The Placeholder is defined as a slot that has been reserved for one or more specific documents not yet created or received. The Placeholder includes a File Object Hook and a Deadline element. The File Object Hook allows actual files to be later attached or linked to the Placeholder. The Deadline element indicates a triggering condition and a time period by which the deadline must be satisfied.<sup>1</sup>

Presented base Claim 1 of the present invention recites "...said workfolder containing a contents node for storing primary data, said contents node containing one or more placeholders within said workfolder, each placeholder being a respective slot that has been reserved for new documents expected to be added to said workfolder via said placeholder, wherein each placeholder includes a file object hook to which a primary data document can later be linked and a deadline element having a triggering condition field for storing a triggering event and an indicated time period relative to the occurrence of said triggering event."

Presented base Claim 28 has similar language and recites "...for each structured workfolder, said template containing a contents node; said contents node containing a placeholder within said workfolder, the placeholder being a slot that has been reserved for new documents expected to be linked to said workfolder, which said documents may or may not exist at the time of workfolder creation, said documents being linkable subsequent to their creation to said workfolder via said placeholder in said workfolder, wherein the placeholder includes a file object hook to which a primary data document can later be linked and a deadline element having a triggering condition field for storing a triggering event and an indicated time period relative to the occurrence of said triggering event."

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<sup>1</sup> See Specification page 7, lines 4 through page 9, line 14 and Figs. 1-2.

To establish a prima facie case of obviousness 1) all claim limitations must be taught or suggested; 2) some teaching, motivation or suggestion to combine must be present in a person of ordinary skill in the art or in cited references; and 3) there must be a reasonable expectation of success.<sup>2</sup>

On page 2 of the Office Action, the Examiner states that Nakagawa teaches the “at least one structured workfolder for storing and organizing electronic documents which the documents may or may not exist at the time of the workfolder creation and the workfolder containing a contents node for storing primary data, the contents node containing one or more placeholders within the workfolder for new documents expected to be added to the workfolder via the placeholder, and wherein each placeholder includes a file object hook to which a primary data document can later be linked and a deadline element having a triggering condition field for storing a triggering event and an indicated time period relative to the occurrence of the triggering event.” On page 6 of the Office Action, the Examiner states “Nakagawa did not teach, the documents may or may not exist at the time of workfolder creation and the documents being linkable subsequent to their creation...”

As to Trede, on page 3 of the Office Action, the Examiner cites Trede as disclosing “each placeholder being a respective slot and a contents node.” On page 12 of the Office Action, the Examiner notes that “...the Trede Assignee is the same Assignee as for the Applicant. Therefore...the Examiner considers the term "placeholder" to have the same meaning and usage as the Applicant's 'placeholder'.” Applicants respond accordingly based on in-context reading of the cited art and interpreting each reference as a whole.

Nakagawa provides a document storing and managing system for storing plural electronic documents in each of plural folders according to classifications and for collectively (i.e., as a unit) managing the stored electronic documents of the folder. The document storing and managing system comprises folder managing means for managing attributes of the electronic

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<sup>2</sup> In re Vaeck, 947 F.2d 488, 20 USPDQ2d 1438 (Fed. Cir. 1991).

documents included in each of the folders, a document version managing means for managing information as to versions of the electronic documents included in each of the folders, and a folder version managing means for managing a correspondence relation between a version of the folder and a version of each of the electronic documents included in the folder.

Nakagawa does not imply or suggest singularly or in any combination with the prior art a placeholder, a file object hook, or a deadline element as claimed in the present invention. With reference to Nakagawa col. 5, lines 32-43, the Examiner suggests that these paragraphs disclose Applicant's file object hook and/or deadline element. However, reading the Nakagawa document as a whole, these paragraphs set forth two ways in which a document (an existing file) is designated as an object of the move operation. In the first way, a version of the document having a number exceeding a predetermined number counted from the last version of the folder is designated as an object of the move. In the second way, a version of the document stored for a period exceeding a predetermined period having elapsed from when the document was made is designated as an object of the move. These determinations and the move operation are part of the high level (system) configuration of the document storage and management system and provide for moving the place for storing files (electronic documents) to a low-speed, large capacity medium. In turn, this enables storing documents in new versions high in frequency of utilization in high-speed medium leaving a margin. See col. 5, lines 26-31 of Nakagawa.

In contrast, the file object hook and deadline element of the present invention are part of the low level structure (specific configuration) of the placeholder ("a slot that has been reserved for new documents") of the present invention.<sup>3</sup> The file object hook "allows actual files to be later attached or linked to the placeholder"<sup>4</sup> and the deadline element "indicates a triggering condition and a period of time by which a deadline must be satisfied."<sup>5</sup> Neither of these claimed document (placeholder) level features are implied or suggested by the cited art. The cited art

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<sup>3</sup> Fig. 2.

<sup>4</sup> See Specification page 7, lines 4 through page 9, line 14 and Figs. 1-2.

<sup>5</sup> Id.

does not even approach the document/placeholder level of detail. Thus, a *prima facie* case of obviousness is arguably unsupported for the claimed "file object" and "deadline element".

The Examiner further states that Trede discloses "each placeholder being a respective slot and a contents node" and "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have each placeholder to be a respective slot by incorporating the teachings of Nakagawa in Trede as taught by Trede because this facilitates the use of holding a place in a hierarchical file system of folders for managing electronic documents when old versions of documents are stored or moved." (Office Action page 3). The Examiner observes Nakagawa does not teach, "each placeholder being a respective slot or a contents node." (Office Action page 3).

Reading Trede as a whole, the term "placeholder" in Trede has a different meaning than the term "placeholder" in the present invention. In Trede, the term "placeholder" is the short form of "placeholder entry". Throughout Trede, it is the placeholder entry that is the main topic of discussion (subject matter). See columns 1 and 2 of Trede. The main term "placeholder entry" (or shortened version "placeholder") in Trede denotes an existing data file, whereas in the present invention the term "placeholder" denotes a slot or reserved space. (Col. 2, lines 11-12, Trede). The Trede placeholder entry (data file) is written when an existing file is moved from one place to another. In Trede, the placeholder entry (data file) contains "migration information" about the moved file. The placeholder entry (data file) allows the user to locate the moved file using the migration information stored in the placeholder entry (data file). (Col. 4, lines 33-47, Trede).

The Examiner acknowledges the term "placeholder" in Trede has a different meaning than the term "placeholder" in the present invention. However, the Examiner cannot simply replace the meaning of the term "placeholder" from Trede with that of the present application because they have a common assignee. First, this is because the words of the presented claims ("placeholder") must be given their plain meaning unless applicant has provided a clear

definition in the specification.<sup>6</sup> In both Trede and the present application the term “placeholder” is clearly defined in the respective specification and therefore the respective definition as described in its associated specification should be used in both instances. (Trede, col. 2, lines 11-12 and present application, page 7, lines 5-7). Second, the applicant may be his or her own lexicographer as long as the term is not repugnant to the term’s well known usage.<sup>7</sup> Further, any special meaning assigned to a term must be sufficiently clear in the specification that any departure from the common usage would be so understood by a person of experience in the field of the invention.<sup>8</sup> As discussed above, the applicant has clearly defined the term “placeholder” in the subject specification as “a slot that has been reserved for one or more specific documents not yet created or received.”<sup>9</sup> The use of this meaning for the term “placeholder” in Trede would make Trede internally inconsistent. Therefore, the definition of term “placeholder” from the present application should not be used as the definition of the term placeholder placeholder entry in Trede.

As previously argued in a prior response, Trede’s data management system provides the capability to move and/or copy the placeholder files (data files) from one file server volume to another file server volume, even if the destination file server volume resides on a different file server. The moving and/or copying of placeholder files (data files) allows continued tracking and user access of files having migration information stored in the placeholders (data files). The moving and/or copying of placeholder files (data files) teaches away from the present invention’s creating and storing new documents within a slot (space) of the WorkFolder reserved by a placeholder. (Col. 12, lines 32-39, Trede).

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<sup>6</sup> See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); MPEP 2111.01.

<sup>7</sup> See In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947); MPEP 2111.01.

<sup>8</sup> See Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998); MPEP 2111.01.

<sup>9</sup> See Specification page 7, lines 5-7.

Restated, the data file system of Trede could be used with the present invention. In that instance, when a structured WorkFolder of the present invention is moved from one memory location to another, the Trede system writes corresponding migration information in a data file entry (Trede's placeholder). Using the migration information written in the Trede style data files, an end user is able to locate the invention WorkFolder and its contents (i.e., existing documents and/or the invention space-reserving placeholders which indicate future expected documents). If various such WorkFolders resided on multiple file servers, the Trede data files would be moved and/or copied onto the different file servers to provide migration information across the file servers. Throughout the foregoing, the invention placeholders within a given WorkFolder are treated synonymously to existing documents for the purposes of the Trede data file system and migration information therein. Thus, when a new document is placed in a placeholder (of Applicants' invention) of a WorkFolder, the migration information of Trede's system continues to track location of the WorkFolder.

As such, Trede and the present invention have different definitions for the term "placeholder". Further, nothing of the Trede system provides for, serves as, teaches, implies or suggests the space-reserving placeholders of the present invention. Any motivation to combine Nakagawa and Trede exists in the management of existing data files and not in handling documents to be created in contrast to the present invention. Even if combined, the likelihood of Nakagawa features (moving the place for storing files of electronic documents from high speed to low speed large capacity mediums) plus Trede features (moving/copying of data files across different server volumes while allowing continued tracking) providing the present invention (placeholder configured with a file object hook and deadline element) is minimal at best. The combination of Trede and Nakagawa would not produce the claimed invention (placeholder including a file object hook and a deadline element). Thus a prima faci case of obviousness is not met.

Since all the limitations of presented base Claim 1, including "...said workfolder containing a contents node for storing primary data, said contents node containing one or more placeholders within said workfolder, each placeholder being a respective slot that has been reserved for new documents expected to be added to said workfolder via said placeholder,

wherein each placeholder includes a file object hook to which a primary data document can later be linked and a deadline element having a triggering condition field for storing a triggering event and an indicated time period relative to the occurrence of said triggering event.,” are not taught, suggested or otherwise made obvious by cited art (Nakagawa and Trede), now presented base Claim 1 is believed to be patently distinguishable over the cited art. Therefore, it would have not been obvious to one of ordinary skill in the art at the time the invention was made to modify Nakagawa with the teachings of Trede to form the invention of presented base Claim 1. Therefore, Applicants respectfully request withdrawal of the rejection of presented base Claim 1 under 35 U.S.C. 103(a)

The above remarks regarding presented base Claim 1 also apply to dependent claims 2-27 by virtue of the fact, that if an independent claim is unobvious under 35 U.S.C. 103, then any claim depending therefrom is unobvious. Therefore, Applicant's respectfully request the withdrawal of the rejection of claims 2-27 under 35 U.S.C. 103(a).

With respect to claims 28-31, the Office Action states “these claims have been rejected for similar rationale given for claims 1, 2, 18, and 22. Applicants respond accordingly.

As discussed above, neither Nakagawa or Trede imply, suggest or otherwise make obvious “a space-reserving placeholder within said workfolder, the placeholder being for new documents expected to be linked to said workfolder” as in the present invention of presented base Claim 28. Rather, as discussed above and acknowledged by the Examiner, Trede and the present invention have different definitions for the term placeholder. Therefore, Trede's placeholder denotes existing data files for holding migration information and not a slot (space) as in the present invention. Further, Trede's moving and/or copying of placeholder files (existing data files) teaches away from the present invention's creating and storing new documents within a slot (space) of the WorkFolder reserved by a placeholder.

Since all the limitations of presented base Claim 28, including “a space-reserving placeholder within said workfolder, the placeholder being for new documents expected to be

linked to said workfolder," are not taught, suggested or otherwise made obvious by cited art (Nakagawa and Trede), presented base Claim 28 is believed to be patentably distinguishable over the cited art. Therefore, it would have not been obvious to one of ordinary skill in the art at the time the invention was made to modify Nakagawa with the teachings of Trede to form the invention of presented base Claim 28. Therefore, Applicants respectfully request withdrawal of the rejection of base Claim 28 under 35 U.S.C. 103(a)

The above remarks regarding presented base Claim 28 also apply to dependent claims 29-36 by virtue of the fact, that if an independent claim is unobvious under 35 U.S.C. 103, then any claim depending therefrom is unobvious. Therefore, Applicant's respectfully request the withdrawal of the rejection of claims 29-36 under 35 U.S.C. 103(a).

Claim 37 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over Trede in view of Nakagawa.

Presented base Claim 37 of the present invention recites "...creating at least one space-reserving placeholder within said workfolder, the placeholder being for new documents which may or may not exist at the time of workfolder creation and are expected to be linked to said workfolder via said placeholder."

As discussed above, Trede or Nakagawa do not imply, suggest or otherwise make obvious "creating at least one space-reserving placeholder within said workfolder, the placeholder being for new documents which may or may not exist at the time of workfolder creation and are expected to be linked to said workfolder via said placeholder" as in the present invention of presented base Claim 37.

Rather, as discussed above and acknowledged by the Examiner, Trede and the present invention have different definitions for the term placeholder. Trede's placeholder denotes existing data files for holding migration information and not a slot (space) as in the present invention. Further, Trede's moving and/or copying of placeholder files (data files) teaches away

from the present invention's creating and storing new documents within a space of the WorkFolder reserved by a placeholder.

Since all the limitations of presented base Claim 37, including "...creating at least one space-reserving placeholder within said workfolder, the placeholder being for new documents which may or may not exist at the time of workfolder creation and are expected to be linked to said workfolder via said placeholder," are not taught, suggested or otherwise made obvious by cited art (Trede), presented base Claim 37 is believed to be patentably distinguishable over the cited art. Therefore, Applicants respectfully request withdrawal of the rejection of presented base Claim 37 under 35 U.S.C. 103(a).

Claims 38-58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Trede in view of Nakagawa. The rejection is respectfully traversed.

Since Claims 38-58 are dependent on presented base Claim 37, the above remarks regarding presented base Claim 37 also apply to dependent claims 38-58 by virtue of the fact, that if an independent claim is unobvious under 35 U.S.C. 103, then any claim depending therefrom is unobvious. Therefore, Applicant's respectfully request the withdrawal of the rejection of claims 38-58 under 35 U.S.C. 103(a).

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims (Claims 1-13 and 15-58) are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 341-0036.

Respectfully submitted,

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